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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/712,819

11/13/2000

Fred J. Stevens

0003/00537

9146

7590

12/18/2001

Cherskov & Flaynik  
The Civic Opera Building  
20 N Wacker Drive  
Chicago, IL 60606

EXAMINER

HUYNH, PHUONG N

ART UNIT

PAPER NUMBER

1644

6

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/712,819	<b>Applicant(s)</b> STEVENS ET AL.	
	<b>Examiner</b> " Neon" Phuong Huynh	<b>Art Unit</b> 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input checked="" type="checkbox"/> Other: <i>Notice to comply</i> .     |

Art Unit: 1644

### DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Group 1640, Technology Center 1600.
2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821 (a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosure.

This application fails to comply with the sequence rules because the computer readable form of the sequence submitted a copy of the "Sequence Listing" in computer readable form, a paper copy and a statement that the content of the paper and computer readable copies are the same, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d) have not been supplied to the Office.

Please see enclosed notice to comply.

3. Claims 1-20 are pending.

### *Election/Restrictions*

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, 15-16, and 17-20, drawn to a method for minimizing the aggregation tendencies of an amyloid forming protein or prevent fibril assembly, classified in class 424, subclass 184.1.
  2. Claim 14, drawn to a peptide, classified in class 530, subclass 329.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process and product of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in materially different processes such as making antibody or screening/binding assays. Therefore, they are patentably distinct.

5. Because these inventions are distinct for the reasons given above and the searches are not co-extensive, restriction for examination purposes as indicated is proper.
6. Irrespective of whichever group the applicant may elect, the applicant is further required under 35 U.S.C. 121 to elect:  
If Group I is elected, the Applicant is required to elect a specific method comprising (1) **the specific protein such as the ones recited in claims 3 and 9**, (2) **the specific peptide such as the ones recited in claims 6 and 12-13**. These various proteins and peptides differ with respect to their structures and physiochemical properties for a method of minimizing the aggregation tendencies of an amyloid forming protein. Therefore, they are patentably distinct.
7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 17 are generic.
8. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.
9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

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10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.
11. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (703) 308-4844. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.
14. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phuong N. Huynh, Ph.D.

Patent Examiner

Technology Center 1600

December 17, 2001

  
CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
GROUP 1800 1600

BACKFILE DOCUMENT INDEX SHEET

A DCPHOENIX

APPL PARTS

IMIS Internal Misc. Paper  
LET Misc. Incoming Letter

371P PCT Papers in a 371Application

A... Amendment Including Elections

ABST

Abstract

ADS

Application Data Sheet

AF/D

Affidavit or Exhibit Received

APPENDIX

Appendix

ARTIFACT

Artifact

BIB

Bib Data Sheet

CLM

Claim

COMPUTER

Computer Program Listing

CRFL

All CRF Papers for Backfile

DIST

Terminal Disclaimer Filed

DRW

Drawings

FOR

Foreign Reference

FRPR

Foreign Priority Papers

IDS

IDS Including 1449

Internal

SRNT

Examiner Search Notes

CLMPTO

PTO Prepared Complete Claim Set

4/25/03

NPL

Non-Patent Literature

OATH

Oath or Declaration

PET.

Petition

RETMAL

Mail Returned by USPS

SEQLIST

Sequence Listing

SPEC

Specification

SPEC NO

Specification Not in English

TRNA

Transmittal New Application

OUTGOING

CTMS

Misc. Office Action

1449

Signed 1449

892

Abandonment

ABN

Board of Appeals Decision

APDEC

APEA

Examiner Answer

CTAV

Count Advisory Action

CTEQ

Count Ex parte Quayle

CTFR

Count Final Rejection

File Wrapper

FWCLM

File Wrapper Claim

IIFW

File Wrapper Issue Information

SFRFW

File Wrapper Search Info

INCOMING

AP.B

Appeal Brief

C.A.D

Change of Address

N/AP

Notice of Appeal

PA..

Change in Power of Attorney

REM

Applicant Remarks in Amendment

XT/

Extension of Time filed separate

